



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,692	01/05/2006	Marlene A. Jacobson	21254P	3011
210 7590 06/11/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907				
EXAMINER HOWARD, ZACHARY C				
ART UNIT		PAPER NUMBER		
1646				
MAIL DATE		DELIVERY MODE		
06/11/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,692

Applicant(s)

JACOBSON ET AL.

Examiner

ZACHARY C. HOWARD

Art Unit

1646

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 19, 21, 23-29 and 31-38 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 8-10, 19, 21, 24-27 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5, 7-10, 19, 21, 23-29 and 31-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application, Amendments and/or Claims

Claims 1-5, 7-10, 19, 21, 23-29 and 31-38 are pending in the instant application.

Election/Restrictions

Applicants' election of Group I, claims 1-5, 7-10, 19, 21, 23-29, 31-33 and 35-38, in the reply filed on 2/28/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 34 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

In the office action mailed 1/28/08, two elections of species were also required.

The following elections of species in the reply filed on 2/28/08 are acknowledged.

(1) Applicants' election of mGluR4 as the species of mGluR. Applicants state that claims 1-5, 7-10, 19, 21, 23, 24, 26-29, 31-33 and 35-38 read upon this elected species. The Examiner agrees with this statement.

(2) Applicants' election of change in intracellular calcium concentration as the species of measurable cellular response. Applicants state that claims 1-3, 7, 19, 23, 28, 31-33 and 35-38 read upon this elected species. The Examiner agrees with this, except with regard to claim 19, as claim 19 depends from claim and therefore must be drawn to the same non-elected species as claim 8.

Claims 4, 5, 8-10, 19, 21, 24-27, 29 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claims 1-3, 7, 23, 28, 31-33 and 35-38 are under consideration.

Elections of Species

On further consideration of the claims in the elected group (Group I), three more elections of species are required, as follows:

(I) Group I contains claims directed to the following patentably distinct species of methods:

(a) methods wherein the test cells are contacted with the test compound and control cells simultaneously [e.g., as in step (a) of claim 1]; and

(b) methods wherein the test cell population is contacted with the test compound independently from the control cell population being contacted with the test compound [e.g., as in steps (a)-(e) in claim 23].

Currently, claims 1-3 and 7 are directed to species (a); claims 23, 28, 33, 37 are directed to species (b) and claims 31, 32, 35, 36 and 38 are generic.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

(II) Group I contains claims directed to the following patentably distinct species of methods:

(a) methods to identify an agonist of a metabotropic glutamate receptor; and

(b) methods to identify an antagonist of the activation of a metabotropic glutamate receptor.

Currently, claims 23, 37 and 38 are directed to species (a); claims 31, 32, 35 and 36 are directed to species (b) and claims 1-3, 7, 28, 33 are generic or recite each species in the alternative.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

(III) Group I contains claims directed to the following patentably distinct species of means for detecting a change in the elected measurable cellular response (intracellular calcium concentration):

- (a) measuring fluorescence of a calcium sensitive dye; and
- (b) measuring a reporter gene operably linked to a regulatory sequence which responds to a change in intracellular concentration of calcium.

Currently, claim 23 is directed to species (a); claims 28 and 31-33 are directed to species (b) and claims 1-3, 7, 35-38 are generic.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

The following statements apply to each election of species required above:

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a

claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary C. Howard whose telephone number is 571-272-2877. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary B. Nickol can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1646

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Z. C. H./
Examiner, Art Unit 1646

/Elizabeth C. Kemmerer/
Primary Examiner, Art Unit 1646